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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,857	06/28/2001	Kenji Kogure	1075.1168	3130
21171	7590	10/18/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PASS, NATALIE	
		ART UNIT	PAPER NUMBER	
			3626	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/892,857	KOGURE, KENJI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 03 August 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1,3-11,13-26 and 28-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-11,13-26 and 28-36 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment filed 3 August 2006. Claims 1, 4, 6, 9, 11, 13-26, 28-34 have been amended. Claims 2, 12, and 27 have been cancelled. Claim 36 has been newly added. Claims 1, 3-11, 13-26, 28-36 remain pending.

***Claim Objections***

2. The objection to claims 27-33 under 37 CFR 1.75(c) for being of improper dependent form is hereby withdrawn due to the amendment filed 3 August 2006.

***Claim Rejections - 35 USC § 112***

3. The rejections of claims 12, 14, 26-34 under 35 U.S.C. 112, second paragraph, for being indefinite is hereby withdrawn due to the amendment filed 3 August 2006.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

5. Claims 1, 3-11, 13-26, 28-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverbrook et al, U.S. Patent Number 6, 959, 298 for substantially the same reasons given in the previous Office Action (paper number 11152005). Further reasons appear hereinbelow.

(A) Claim 1 has been amended to include the recitation of

- ♦ "[...] an input assisting section for assisting in inputting the personal data of the remaining customers of the group using part of said first registration data which part is common to the group [...]," at lines 15-17.

As per these new limitations, Silverbrook teaches an apparatus as analyzed and discussed in the previous Office Action (paper number 11152005), further comprising an input assisting section for assisting in inputting the personal data of the remaining customers of the group using part of said first registration data which part is common to the

group (Silverbrook; Figure 63, Figure 65, Figure 81, column 47, line 67 to column 48, line 1, column 49, lines 6-13, column 50, lines 44-60).

The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper 11152005, section 6, page 8), and incorporated herein.

(B) The amendments to claims 4, 6, 9, 13-25, 28-34 appear to have been made merely to correct minor typographical or grammatical errors or to overcome claim objections or rejections under 35 USC § 112 and to change dependencies. While these changes render the language of the claim smoother and more consistent, they otherwise affect neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 11152005, section 6, pages 4-8), and incorporated herein.

(C) Claims 3, 5, 7-8, 10, and 35 have not been amended and are rejected for the same reasons given in the previous Office Action (paper 11152005, section 6, pages 4-8), and incorporated herein.

(D) Amended method claim 11 repeats the subject matter of amended apparatus claim 1, as a series of steps rather than a set of apparatus elements. As the underlying structure of claim 1 has been shown to be fully disclosed by the teachings of Silverbrook in the above rejection of claim 1, it is readily apparent that the system disclosed by Silverbrook includes the

steps to perform these functions. As such, these limitations are rejected for the same reasons given above for apparatus claim 1, and incorporated herein.

(E) Amended claim 26 differs from method claim 11 by reciting a “computer readable recording medium ...” in the preamble. As per this limitation, Silverbrook clearly discloses his invention to be implemented on a “computer readable medium ...” (Silverbrook; column 2, lines 42-59). The remainder of amended claim 26 repeats the limitations of claim 11, and is therefore rejected for the same reasons given above for claim 11.

(F) As per newly added claim 36, Silverbrook teaches a method of engaging a group of customers having common personal data in a single collective contract or a plurality of individual contracts with another party, the method comprising:

deriving registration data which part is common to the group of customers, from registration data of a first customer (Silverbrook; Figure 51, Figure 63, Figure 81, column 47, line 66 to column 48, line 2, column 49, lines 6-13, column 50, lines 44-60);

merging the derived registration data with at least a name inputted for each remaining customers of the group (Silverbrook; Figure 51, Figure 63 to Figure 65, Figure 81 to Figure 84, column 47, line 66 to column 48, line 2, column 49, lines 6-13, column 50, lines 44-60); and

processing and executing the single collective contract or the individual contracts with respect to the group of customers based on the registration data of the first customer and the merged registration data of the remaining customers of the group (Silverbrook; Figure 51, Figure

63 to Figure 65, Figure 81 to Figure 84, column 47, line 66 to column 48, line 2, column 49, lines 6-13, column 50, lines 44-60).

***Response to Arguments***

6. Applicant's arguments filed 3 August 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 3 August 2006.

(A) At pages 10-11 of the 3 August 2006 response, Applicant argues that the features in the Application are not taught or suggested by the applied reference. In response, all of the limitations which Applicant disputes as missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of Silverbrook, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 11152005), and incorporated herein. Specifically, Examiner notes that the recited features of "an input assisting section for assisting in inputting the personal data of the remaining customers of the group using part of said first registration data which part is common to the group" are taught by the applied reference. In particular, Examiner interprets Silverbrook's teaching of "[e]ach policy covers one or more travelers" (Silverbrook; column 47, line 66 to column 48, line 2) together with the input assisting sections of Figures 63 and 81, that assist in inputting the remaining

customers of the group, together with the flow chart of Figure 51, to be a form of “assisting in inputting the personal data of the remaining customers of the group using part of said first registration data which part is common to the group.” (Silverbrook; Figure 51, Figure 63 to Figure 65, Figure 81 to Figure 84, column 47, line 66 to column 48, line 2, column 49, lines 6-13, column 50, lines 44-60), and as teaching these limitations.

With respect to Applicant’s argument at paragraph 2 on page 11 of the 3 August 2006 response that the cited lines in the Silverbrook reference do not disclose the “number of customers remaining in the group,” as recited in amended claims 9, 23, and 34, Examiner notes that it is the entire applied reference, and not only the cited passages that must be considered when evaluating whether or not the applied references teach the cited limitations. Furthermore, Examiner notes that Figure 81 of the Silverbrook reference also includes this feature for a group of travelers.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

**or faxed to:** (571) 273-8300.

For formal communications, please mark

"EXPEDITED PROCEDURE".

For informal or draft communications, please  
label "PROPOSED" or "DRAFT" on the front page of  
the communication and do NOT sign the  
communication.

After Final communications should be labeled "Box AF."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

October 12, 2006



JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER